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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Christian KUNERT et al.

Director art unit
1700:

Marian C. KNODE

Serial No.: 10/713,050

Examiner:

Karl E. GROUP

Filed: November 17, 2003

Group Art Unit: 1755

Title: USE OF A GLASS FOR THERMAL SHOCK-RESISTANT BEVERAGE
CONTAINERS

PETITION UNDER 37 C.F.R. 1.81

Director of Group 1700 - Marian C. Knode
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Advisory Action mailed 28 February 2005 and the Final Office
Action mailed 24 November 2004, please consider:

Remarks/Arguments that begin on page 2 of this paper.

REMARKS

Applicants hereby petition the objections to the priority and specification in the Office Action mailed 24 November 2004, which were made final by the Advisory Action of 28 February 2005.

Statement of Facts

The present application is a continuation of U.S. Application No. 09/532,966 filed 22 March 2000, now abandoned. In the parent application, the Board of Patent Appeals and Interferences decided that the term "colorless" was new matter. Appellants argued that the glass at page 2 of the specification was inherently colorless, and would be so recognized by one of ordinary skill in the art. At the paragraph bridging pages 7 - 8 of the Board's decision, the Board was unpersuaded by Appellants' argument and noted that no evidence was provided to support the contention that the glass at page 2 of the specification is indeed colorless. This continuation was filed, at least partly, in order to submit such evidence.

In the Action mailed 22 July 2004 in the present application, the Examiner objected to the Application's priority because the terminology "colorless" in the claim was not supported in the parent specification. Consequently, the Examiner requested that the present application be listed as a continuation-in-part. The Examiner also objected to the specification for failing to provide antecedent basis for the term "colorless". In Applicants' reply submitted 26 October 2004, Applicants provided a declaration providing evidence that the glass described at page 2 of the disclosure is indeed inherently "colorless". In response to this new evidence, the Final Office Action mailed 24 November 2004 maintained the priority and specification objections. Although the Action did not provide a rejection under 35 U.S.C §112, first paragraph, the Examiner briefly addressed the evidence under the priority objection. Applicants filed their Reply on 24 January 2005 requesting reconsideration of the priority and specification objections. These objections, which are being petitioned by this paper, were finalized by the Advisory Action mailed 28 February 2005.

Points to be Reviewed

1. The Priority Objection.

Wrong Standard Applied For Determining Benefit Under 35 U.S.C §120

The Examiner alleges that an application cannot be considered a continuation unless

the disclosures are identical. The Examiner expounds on this rationale in the Advisory Action by stating that the claims must have antecedent basis in the disclosure, and the instant disclosure must be amended to include "colorless" if the limitation is present in the claims. The Advisory Action further concludes that because such an amended disclosure is required, the specification disclosures would not be identical and therefore the claim priority would be improper. However, the assertion that the parent and continuation specifications must be identical to support a priority claim is erroneous.

The standard for determining compliance of a claim with 35 U.S.C §120 to obtain the filing date of an earlier filed U.S. application is not whether the specifications are identical. Rather, there are six conditions for receiving the benefit of an earlier filing date (see, e.g., M.P.E.P. §201.11), with the condition relevant to the current discussion being that the claim is entitled to an earlier filing date if the subject matter of the claim is disclosed in the manner provided in 35 U.S.C § 112, first paragraph, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 U.S.P.Q.2d 1829 (Fed. Cir. 1998); and M.P.E.P. §201.11. With respect to whether the subject matter of the pending claims is disclosed in the manner provided by 35 U.S.C §112, first paragraph in the parent Application No. 09/532,966, Applicants respectfully submit that the pending claims are supported, as further discussed below.

Even if the standard for compliance with 35 U.S.C §120 is identical specifications, the Office Action is in error in stating that the current specification and parent specification are not identical. They are identical. Thus, the current application is properly indicated as a continuation and it would be improper to indicate it as a continuation-in-part. The fact that new claims are provided in this application does not change the identical of nature of the specifications and the proper "continuation" status of this application.

Failure To Properly Address The Evidence Submitted 26 October 2004

The Examiner states correctly that the Board decision (Appeal No. 2003-0694) determined that the specification of parent application no. 09/532,966 did not support the terminology "colorless". However, the Board based this decision on the failure of Appellants to provide evidence that the glass at page 2 of the specification is colorless.

As discussed in Applicants' reply of 26 October 2004, *res judicata* is not applicable when the same issue or same fact setting is not involved. See M.P.E.P. §706.03(w). The Examiner here improperly relies on the Board's decision in supporting the objection to priority because new facts, e.g., the declaration, are now of record.

In the instant application, a declaration and exhibit were provided with Applicants' reply of 26 October 2004 providing evidence that the present specification, which is identical to the parent specification as discussed above, inherently provides support for the term "colorless". Consequently, a decision based on *res judicata* is improper because different facts are present before the Examiner than were before the Board, with respect to 35 U.S.C §112, first paragraph. Specifically, Applicants have now included evidence in the record that the parent specification provides inherent support for the claimed "colorless" glass. This evidence was not before the Board. Thus, the Board's decision no longer has *res judicata* effect.

Although the Examiner fails to provide a ground of rejection, he substantively addresses the declaration under the priority objection. Particularly, the Examiner alleges that the terminology "decolorant" in the disclosure encompasses compounds that counteract the effect of iron even if the effect is the addition of a color. Both decolorants listed in the instant disclosure are allegedly known to have a coloring effect. Thus, the Examiner concludes in the Action that the Applicants have not shown by way of tangible evidence that the additional listed decolorants still result in a colorless glass. The Examiner in the Advisory Action expands on this rationale by asserting that the term "counter act" or "hide" does not equate to a colorless glass, and alleges that the Applicants assert that the decolorant forms a colorless glass.

Applicants respectfully submit that these assertions are erroneous and the point of the declaration is misconstrued. The declaration was submitted to establish that one of skill in the art would readily recognize that the glass at page 2 is colorless. The decolorant does not form a colorless glass because the glass is inherently colorless. That fact in and of itself supports the inherent disclosure of "colorless" in the specification.

The Action ignores the specification and prosecution history of the Parent Application No. 09/532,966 filed 22 March 2000, as well as the recently submitted declaration. As discussed in the Reply Brief 5 August 2002, the specification at page 3 provides:

It is also possible for decolorants, such as, for example Er_2O_3 or CoO , to be included, which counteract or hide the coloring effect of iron which is usually present in the raw materials.

Emphasis added.

As discussed in the specification, the decolorant counteracts or hides the coloring effect of iron. The rationale by the Board for sustaining the rejections was that Appellants failed to establish that a glass as disclosed at, e.g., page 2 of the specification, was in fact colorless. The declaration submitted with Applicants' last reply provides more than sufficient

evidence that such a glass is colorless. The optional decolorant is only added if such a glass contains impurities, such as iron. Thus, as discussed in the prosecution of the parent application, if such a glass as disclosed at page 2 has an impurity which would render it not colorless, an optional decolorant can be added to counteract or hide such a color to return the glass to being colorless. See, e.g., Appellants' Appeal Brief filed 25 April 2002, Reply Brief filed 5 August 2002, and Reply Brief filed 5 November 2002, along with accompanying attachments, in Application No. 09/532,966. Additionally, the declaration at page 4 provides evidence that the decolorant is optional to offset impurities and to maintain the glass as colorless. Consequently, Applicants respectfully submit that there is sufficient evidence so that one of ordinary skill in the art would readily recognize that the term "colorless" is inherently supported by the specification.

Finally, the issue of whether Applicants complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C §120 was not before the Board in the prior decision. The issue before the Board was a rejection under 35 U.S.C §112 of whether the specification supported the term "colorless" in a claim. Consequently, whether the claims of the present application have a priority claim is not subject to *res judicata*. Therefore, it is improper for the Action to deny Applicants' priority claim until the issue of the term "colorless" in view of the new evidence is examined with respect to the requirements of 35 U.S.C §112.

2. Specification Objections

The Examiner in the Advisory Action states that the instant disclosure must be amended to include the "colorless" limitation if it is present in the claims. However, this standard is incorrect. 37 C.F.R. §1.75(d)(1) provide that the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of terms in the claims may be ascertainable by reference to the description. As discussed above, the glass at page 2 of the specification is inherently colorless, and would be so recognized by one of skill in the art. Consequently, the specification does provide clear support for this terminology. Moreover, §608.01(o) entitled "Basis for Claim Terminology in Description" provides that the meaning of every term used in any of the claims **should** be apparent from the description portion of the specification. What is more, that section goes on to state that Applicants **should** make appropriate amendment of the specification wherever this nomenclature is departed or the Examiner **should** ensure that the terms and phrases used in the claims presented late in prosecution of the application find clear support in the antecedent

basis. Consequently, the standards used in this section of the manual is not "must" but rather "should". Thus, the Examiner is applying the wrong standard for this objection.

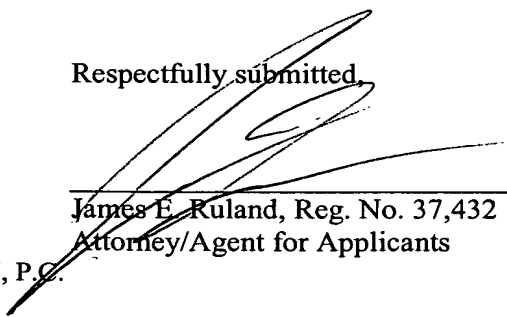
However, Applicants respectfully submit that once the issues pertaining to the term "colorless" are resolved in the claims, Applicants will consider amending the specification to include the term "colorless". It is noted, however, that the specification need not provide literal support; inherent or implicit support is sufficient. See, e.g., *In re Wertheim et al.*, 541 F2d. 257, 191 U.S.P.Q. 90 (CCPA 1976). In this case, as shown by the declaration, the "colorless" feature of the glass is inherently disclosed. Thus, it should not be necessary to amend the specification to add the "colorless" term. At this time, it appears premature to amend the specification until these other issues are resolved.

Relief

Consequently, Applicants petition to have these priority and specification objections withdrawn. In addition, if the Examiner concludes that the present specification, after consideration of the evidence, does not support the claims, then Applicants respectfully petition the Examiner to provide a rejection under 35 U.S.C §112, first paragraph. Failing to provide such a rejection deprives Applicants of their ability to appeal the case to the Board of Patent Appeals. However, Applicants submit that such a rejection is inappropriate because the declaration establishes support for the term "colorless", as discussed above.

We believe no fees are due, however if the Examiner indicates that fees are due, the Commissioner is hereby authorized to charge any additional fees associated with this response, and not included herewith, or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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Attorney Docket No.: SGW-0097-C02

Date: 11 March 2005